

Application No. 09/423,037
After Final Office Action of May 1, 2007

Docket No.: ASZD-P01-228

REMARKS

Claims 1 and 3-22 are pending in the subject application. Claims 5, 6, and 14-22 are withdrawn as being directed to a non-elected invention. Claims 2 and 23 are cancelled. Claims 1, 7, 9 and 12 are rejected and claims 3, 4, 8, 10, 11 and 13 are objected to as being dependant upon a rejected base claim. Applicants have amended claim 1 and respectfully request reconsideration in view of the following remarks.

Claim Rejection under U.S.C. § 103(a)

The Final Office Action rejects claims 1, 7, 9, and 12 as allegedly being unpatentable over Lee et al. in view of Onate et al. The Examiner argues that Lee et al. disclose a binding assay of TRIP-1, which contains an MLELL motif, with a liganded nuclear thyroid hormone receptor transcription factor. The Examiner alleges that in view of the SRC-1 studies performed by Onate and co-workers, wherein SRC-1 is identified as a transcription coactivator, the current claims are anticipated. In response to the rejection, Applicants have amended claim 1 and request reconsideration in view of the following remarks.

Claim 1 has been amended to recite a method utilizing an 8-10 amino acid fragment of a nuclear protein. Support for this amendment can be found on page 3, lines 11-17 of the application as filed. Applicants respectfully submit that the claims as amended are patentable over Lee and Onate noting, pursuant to MPEP 2142, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

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The subject matter of claim 1 as amended and those claims dependant thereon is neither taught nor suggested by Lee or Onate. Lee points out a conserved region of ~200 amino acids among proteins expressing ATPase activity, he has not however taught or suggested any 8-10 amino acid portion thereof that might be useful for binding a liganded thyroid hormone receptor. Furthermore, Lee does not suggest contacting nuclear protein fragments, no less 8-10 amino acid fragments as recited in the amended claims, with a potential inhibitor and a liganded thyroid hormone receptor.

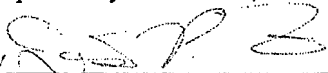
Onate fails to overcome the deficiencies of Lee. Onate neither teaches or suggests a particular binding sequence within the SRC-1 domain and offers no suggestions for truncating this sequence to a length as recited in the current claims. There is no motivation for combining Lee and Onate and doing so would offer no expectation of success. As neither Lee nor Onate teach or suggest the specific binding domain of the nuclear protein, no less a fragment as small as 8-10 amino acids that binds with the nuclear receptor, Applicants respectfully request reconsideration of claim 1 and dependant claims 3, 4, and 7-13.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Please charge any fees due with this response to our Deposit Account No. 18-1945, under Order No. ASZD-P01-228 from which the undersigned is authorized to draw.

Dated: 10-1-07

Respectfully submitted,

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